

REMARKS

By the present amendment claims 1, 6, 11 and 13 have been amended as suggested by the Examiner. Claims 19-22 have been newly added.

Claims 1-22 are thus pending in the application.

In the Office Action, the Examiner rejected claims 1-14 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,542,936 to Mayle et al. in view of U.S. Patent Number 6,583,799 to Manolis et al.

In view of the arguments that follow, Applicant respectfully traverses the Examiner's rejection of claims 1-18.

Rejection Under 35 U.S.C. § 101

The Examiner rejected claims 1-14 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

The Examiner alleged that the combined limitations in claims 1, 6, 11 and 13 can be interpreted as a series of mental and/or manual steps for creating a catalog. The Examiner suggested that the preamble of the claims should be changed to read --A computer executable template . . . --.

Applicant respectfully submits that claims 1, 6, 11 and 13 have been amended as suggested by the Examiner. Therefore the rejection of claims 1-14 should be withdrawn.

Rejection Under 35 U.S.C. § 103

The Examiner rejected claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Mayle et al. in view of Manolis et al. The rejection is respectfully traversed.

Applicant's amended claim 1 recites a computer executable template displaying method comprising the steps of: reading a user image and a plurality of templates each having an image insertion area for inserting the user image therein; inserting the user image in the image insertion area of each of the templates and generating a catalog of the templates each having the user image therein; and displaying the catalog.

The Examiner alleged that Mayle et al. teaches a method of creating an image display, by referencing the abstract and col. 2, lines 35-51. According to the Examiner, Mayle et al.'s customization process is a series of input screens associated with a clickable tab in which the screens can be interpreted as a series (plurality) of templates, because each screen is specifically tailored to input and produce a piece of a final structured result (intermediate results are also displayed as a postcard is built), by referencing col. 8, lines 21-42 and 60-67, and Figs. 6-17. The Examiner further alleged that a user can choose an image for insertion, by referencing Figs. 9-10. The Examiner also alleged that no particular tab order is specified, therefore when a photo is inserted, the photo is essentially inserted in all of the templates, by referencing Fig. 11; and the display of a "Baby Journal" and "Family Album" are forms of catalogs typically comprising user images, by referencing col. 13, line 50 – col. 14, line 12.

The Examiner admitted that Mayle et al. do not specifically teach displaying the templates within said catalog. To cure the deficiencies of Mayle et al., the Examiner alleged that Manolis et al. teach uploading image data forming a catalog of images displayed to a user, by referencing the abstract and Figs. 8-9. According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply Manolis et al. display of user images to Mayle et al., so that each template of Mayle et al. can be displayed concurrently to a user for more concise inspection and customization, resulting in a more complete baby journal/family album.

Applicant respectfully submits that neither Mayle et al. nor Manolis et al., taken singly or combination (assuming these teachings may be combined, which Applicant does not admit), disclose or teach a computer executable template displaying method for "inserting the user image in the image insertion area of each of the templates and generating a catalog of the templates each having the user image therein," as recited in claim 1.

Mayle et al. disclose a system for creating an image display such as an electronic postcard. The electronic postcard is displayed in a browser window of a display screen, which allows a user to upload an electronic image onto a server of the browser window and place the image onto the front of the electronic postcard. The browser window also allows a user to merge text information with the electronic image. Once the text information and electronic image is merged onto the electronic postcard, the electronic postcard may be sent via e-mail by adding sender and recipient email address in an email address field. The system of Mayle et al. may also be used to create a baby journal or photo album, in

which the server may impose a fixed structure such as one specific frame and format for one page holding the image. The input screens of Mayle et al. are merely browser windows in a user interface for allowing a user to develop the electronic postcard in a series of steps to upload an electronic image and input text onto the electronic postcard. The browser windows as disclosed in Figs. 6-16 of do not include a **plurality of templates** that are displayed on a catalog for inserting an image into each template. The browser windows (screen) in the user interface of the display Mayle et al. are not analogous to a plurality of templates. Moreover, each browser window (screen) merely consists of the same electronic postcard in various steps of inputting text and uploading an electronic image onto the electronic postcard.

Monalis et al. do not cure the deficiencies of Mayle et al. Monalis et al. merely discloses uploading images into a plug-in area of screen shots on a web page, in which the images can be viewed on the web page in a browser window of a client computer. The plug-in area of the screen shots on the web page causes thumbnails of the images to be displayed in the image area of the web page. However, the thumbnails of the images in Monalis et al. do not include templates in which the images are inserted. Therefore, the image area of the web page in which the images are inserted is not analogous to "the image insertion area of each of the templates and generating a catalog of the templates each having the user image therein," as recited in claim 1.

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, the proposed modification of the prior art must have had a reasonable expectation of succeeding, as determined from the vantage point of a skill artisan at the time the invention was made. Third, the prior art references, when combined, must teach or suggest all the claim limitations. See M.P.E. P. §2143.

In view of the above reasons, Applicant respectfully submits that the asserted combination of Mayle et al. and Monalis et al. fails to establish a *prima facie* case of obviousness of independent claim 1, or any claim depending therefrom. Therefore, the rejection of claim 1 should be withdrawn. Applicant also respectfully submits that the rejections of dependent claims 2-5 should also be withdrawn for at least the same reasons given above with regard to respective base claim 1.

Applicant also respectfully submits that the rejection of claim 15, which recites a computer-readable medium storing a program to cause a computer to execute a template displaying method, is analogous to claim 1 and should be withdrawn for the same reasons given above with regard to claim 1. The rejection of dependent claim 16 should also be withdrawn for at least the same reasons given with regard to respective base claim 15.

Applicant respectfully submits that the rejection of claim 11, which recites a "catalog generating means for generating a catalog of the templates by inserting the user image in the image insertion area of each of the templates," should also be withdrawn for the same reasons given above with regard to claim 1. Also, the rejection of dependent claim 12

should be withdrawn for at least the same reasons given with regard to respective base claim 11.

Applicant respectfully submits that claims 6 and 17, which recites "generating templates having the user images therein by inserting the respective user images in the image insertion area of the template while generating a catalog of the templates having the user images," should be withdrawn for the same reasons given above with regard to claim 1. The rejection of dependent claims 7-10 and 18 should also be withdrawn for at least the same reasons given with regard to their respective base claims.

Applicant also respectfully submits that the rejection of claim 13 which recites "catalog generating means for generating templates having the user images therein by inserting the respective user images in the image insertion area of the template and for generating a catalog of the templates having the user images," should be withdrawn for the same reasons given above with regard to claim 1. The rejection of dependent claim 14 should also be withdrawn for at least the same reasons given with regard to respective base claim 13.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Demetra R. Smith-Stewart (Reg. No. 47,354), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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